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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/837,852

04/18/2001

Brian Mark Shuster

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EXAMINER

FADOK, MARK A

ART UNIT

PAPER NUMBER

3625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/837,852

Applicant(s)

SHUSTER, BRIAN MARK

Examiner

Mark Fadok

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2006 and 20 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-12 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-12, and 14-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The examiner is in receipt of applicant's response to office action mailed 5/19/2006, which was received 10/19/2006. Acknowledgement is made to the amendment to claims 1 and 9 and the cancellation of claims 4 and 13, leaving claims 1-3, 5-12, and 14-17 as pending in the instant application. Applicant's amendment and remarks have been carefully considered and were found to be persuasive, however, after further researching and are view of office action mailed 7/16/2004, the examiner restates that rejection below modified as necessitated by amendment:

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-12, and 14-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson (6,591,250).

In regards to claim 1, Johnson discloses a method for managing virtual properties that exist solely in a virtual form within a computer network and that have no physical counterparts (col 18, lines 20-25), comprising:

Johnson teaches providing virtual properties for use in a game (col 18, 20-35), This embodiment provides for the digital copies to be places on a client computer. The reasoning for this improvement over the conventional system of server stored objects can be found in col 9, lines 64-67, where it is explained that large numbers of properties would require a large amount of disk space. Johnson teaches a central computer to store the virtual properties (col 17, lines 25-40). Johnson would be motivated to use the central server embodiment for the game when the value of the objects becomes significant (col 13, lines 7-15).

assigning ownership of the virtual properties to a plurality of owners participating in the computer game (FIG 5C),

said ownership configured through said computer game such that said property owners are permitted to use said virtual properties in said computer game but are not permitted to possess a digital copy of any of said virtual properties (see FIG 10 and discussion above);

maintaining an inventory of said virtual properties in a centralized database accessible by said property owners via a network connection (FIG 10);

allowing said property owners to transfer ownership of their respective virtual properties via said network connection (col 17, lines 40-50); and

maintaining updated records regarding ownership or their respective virtual properties in said centralized database (FIG 5C).

In regards to claim 2, Johnson teaches wherein said step of maintaining an inventory comprises searching for a desired one of said virtual properties within said memory (col 17, lines 23-54).

In regards to claim 3, Johnson teaches wherein said step of maintaining updated records regarding ownership comprises associating said virtual properties with respective ones of said property owners (col 5, lines 9-25).

In regards to claim 5, Johnson teaches wherein said step of allowing said property owners to transfer ownership comprises allowing the property owners to sell their respective virtual properties to buyers (col 17, line 24-38).

In regards to claim 6, Johnson teaches wherein said step of allowing said property owners to transfer ownership comprises allowing said property owners to trade their respective properties for other ones of said virtual properties (col 3, lines 21-32).

In regards to claim 7, Johnson teaches wherein said step of allowing property owners to transfer ownership comprises allowing at least one of said property owners to win one of said virtual properties from another property owner in the course of the game (col 3, lines 21-32).

In regards to claim 8, Johnson teaches the step of coordinating with partners via said network to identify additional virtual properties not included in said inventory (col 18, line 600).

In regards to claims 9-12 and 14-17, these claims are considered parallel to claims 1-3,5-8 above and are rejected for the same rationale.

Response to Arguments

Applicant's arguments provided in the 10/19/2006 response with respect to claims 1-3,5-12 and 14-17 have been considered but are moot in view of the new ground(s) of rejection.

Since the previous rejection from 7/16/2004 is being reintroduced, the arguments provided by the applicant on 10/20/2004 will be addressed below.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., ...have no value outside the digital environment in which they exist, the discussion involving objects and the discussion involving unauthorized copies.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that Johnson teaches tracking ownership of various objects without maintaining an inventory of the objects themselves. The examiner disagrees and as noted supra, Johnson teaches the system of maintaining objects centrally, but suggests an improvement by maintaining the objects locally. It is clear from Johnson's discussions that if the value of the virtual properties were significant these may be maintained centrally.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

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Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Johnson does not teach away which is evident in the arguments presented by the examiner supra.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**.

The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey A. Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300 [Official communications; including
After Final communications labeled
"Box AF"]

For general questions the receptionist can be reached at

571.272.3600

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Mark Fadok', with a long horizontal flourish extending to the right.

Mark Fadok

Primary Examiner